

ESTTA Tracking number: **ESTTA521821**

Filing date: **02/15/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	California Products Corporation
Granted to Date of previous extension	02/20/2013
Address	150 Dascomb Road Andover, MA 01810 UNITED STATES
Attorney information	Andrea J. Mealey Hinckley Allen & Snyder LLP 28 State Street Boston, MA 02109 UNITED STATES Tmdocket@haslaw.com Phone:617-345-9000

Applicant Information

Application No	85630325	Publication date	10/23/2012
Opposition Filing Date	02/15/2013	Opposition Period Ends	02/20/2013
Applicants	Plexicoat America, LLC 2709 Rolling Road Suite 123 Baltimore, MD 21244 UNITED STATES Brodsky, Robert M 36 Diamond Crest Ct Baltimore, MD 21209 UNITED STATES		

Goods/Services Affected by Opposition

Class 017.

All goods and services in the class are opposed, namely: Rapid cure, high strength, polymer-based concrete patching compound

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1759340	Application Date	06/22/1992
Registration Date	03/23/1993	Foreign Priority	NONE

		Date	
Word Mark	PLEXICHROME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 002. First use: First Use: 1953/00/00 First Use In Commerce: 1953/00/00 surface coatings in the nature of paint for asphalt, concrete, and athletic surfaces such as tennis courts		

U.S. Registration No.	1950495	Application Date	08/08/1994
Registration Date	01/23/1996	Foreign Priority Date	NONE
Word Mark	PLEXIFLOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 002. First use: First Use: 1991/00/00 First Use In Commerce: 1991/00/00 polymer surface coating composition for multisport gymnasium floors		

U.S. Registration No.	971728	Application Date	08/26/1971
Registration Date	10/30/1973	Foreign Priority Date	NONE
Word Mark	PLEXI-CUSHION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U012 (International Class 019). First use: First Use: 1970/03/23 First Use In Commerce: 1970/03/23 RESILIENT SUB-SURFACE COATING COMPOSITIONS FOR ASPHALT AND CONCRETE		

U.S. Registration No.	894446	Application Date	07/29/1969
Registration Date	07/14/1970	Foreign Priority Date	NONE
Word Mark	PLEXIPAVE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class U016 (International Class 002). First use: First Use: 1961/02/28 First Use In Commerce: 1961/02/28 ACRYLIC COLOR COATING FILLER FOR ASPHALT AND CONCRETE

U.S. Registration No.	971727	Application Date	08/26/1971
Registration Date	10/30/1973	Foreign Priority Date	NONE

Word Mark	PLEXI-TRAC
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class U012 (International Class 019). First use: First Use: 1970/08/12 First Use In Commerce: 1970/08/12 RESILIENT ELASTOMERIC COATING COMPOSITIONS FOR ASPHALT, CONCRETE AND WOOD
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U.S. Registration No.	1124927	Application Date	09/22/1978
Registration Date	09/11/1979	Foreign Priority Date	NONE

Word Mark	PLEXICOURT
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 019. First use: First Use: 1972/02/29 First Use In Commerce: 1972/02/29 PAVING MATERIAL FOR TENNIS COURTS AND SIMILAR PLAY AREAS
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Related Proceedings	91199740
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Andrea J Mealey/
Name	Andrea J. Mealey
Date	02/15/2013

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Mark: PLEXICRETE

Serial No.: 85/630325

Date of Filing: May 21, 2012

Date of Publication: October 23, 2012

CALIFORNIA PRODUCTS
CORPORATION

Opposer,

v.

BRODSKY, ROBERT M

Applicant.

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Opposition No.: _____

NOTICE OF OPPOSITION

Opposer, California Products Corporation (“Opposer”), is a Massachusetts corporation, with an address of 150 Dascomb Road, Andover, MA 01810.

Opposer believes that it will be damaged by registration of U.S. Trademark Application Serial No. by 85/630325 filed by Robert M. Brodsky (“Applicant”) for the mark PLEXICRETE, covering, “rapid cure, high strength, polymer-based concrete patching compound,” in Class 17.

As grounds in support for this opposition, Opposer alleges the following:

1. Opposer has operated for over fifty-eight (58) years as a manufacturer and distributor of surfacing systems.

2. Opposer is the owner of the following six (6) U.S. Trademark Registrations (collectively, the “PLEXI Marks”):

Mark: PLEXICHROME
Registration No.: 1,759,340
Registration Date: March 23, 1993
App. Date: June 22, 1992
Date of First Use: 1953
Goods: Class 2 - Surface coatings in the nature of paint for asphalt, concrete, and athletic surfaces such as tennis courts

Mark: PLEXIFLOR
Registration No.: 1,950,495
Registration Date: January 23, 1996
App. Date: August 8, 1994
Date of First Use: 1991
Goods: Class 2 - Polymer surface coating composition for multisport gymnasium floors

Mark: PLEXI-CUSHION
Registration No.: 971,728
Registration Date: October 30, 1973
App. Date: August 26, 1971
Date of First Use: March 23, 1970
Goods: Class 19 - Resilient sub-surface coating compositions for asphalt and concrete

Mark: PLEXIPAVE
Registration No.: 894,446
Registration Date: July 14, 1970
App. Date: July 29, 1969
Date of First Use: February 28, 1961
Goods: Class 2 - Acrylic color coating filler for asphalt and concrete

Mark: PLEXI-TRAC
Registration No.: 971,727
Registration Date: October 30, 1973
App. Date: August 26, 1971
Date of First Use: August 12, 1970
Goods: Class 19 - Resilient elastomeric coating compositions for asphalt, concrete and wood

Mark: PLEXICOURT
Registration No.: 1,124,927
Registration Date: September 11, 1979
App. Date: September 22, 1978
Date of First Use: February 29, 1972

Goods: Class 19 - Paving material for tennis courts and similar play areas

3. Opposer's registration of each of the PLEXI Marks on the Principal Register is *prima facie* evidence of the validity of each such registration and creates a presumption that each of the PLEXI Marks is inherently distinctive.

4. The registrations for the PLEXI Marks constitute notice to Applicant of Opposer's claim of ownership of the PLEXI Marks.

5. Opposer is the world's largest manufacturer and distributor of sports surfacing systems.

6. Opposer's surfacing systems marketed, distributed and sold under the PLEXI Marks are used in residential and commercial installations.

7. Opposer's surfacing systems identified by the PLEXI Marks have been chosen and installed by many sport venues such as stadiums in the United States hosting national tennis tournaments.

8. Opposer's surfacing systems identified by the PLEXI Marks are installed at many University and College stadiums in the United States.

9. Through the Opposer's website www.plexipave.com, consumers can locate contractor installers of Opposer's surfacing systems identified by the PLEXI Marks.

10. Since commencing operation in 1953, Opposer has been manufacturing surfacing systems under various of the PLEXI Marks.

11. Opposer's use of the PLEXI Marks has been continuous.

12. Opposer has not abandoned any of the PLEXI Marks.

13. Opposer has expended considerable time, effort and resources in the advertisement, promotion, sale and distribution of its products bearing the PLEXI Marks.

14. Through its advertising and marketing efforts over the years, Opposer has established a strong and loyal customer base.

15. Opposer is known throughout the surfacing industry and to consumers as a manufacturer of high quality sports surfacing systems.

16. The recognition of and goodwill associated with Opposer's PLEXI Marks are the results of Opposer's continuous marketing and promotional efforts and sales over a period of approximately fifty-eight (58) years and by virtue of high quality of Opposer's surfacing systems offered under the PLEXI Marks.

17. In accordance with Sections 7(b), 22 and 33(a) of the Lanham Trademark Act, Opposer's PLEXI Marks constitute *prima facie* evidence of the validity of the registered marks and of the registrations thereof, Opposer's ownership of the marks shown in said registrations, and Opposer's exclusive right to use the marks in commerce in connection with the goods named therein, without condition or limitation.

18. Applicant filed his application, Trademark Application Serial No. 85/630235, for the mark PLEXICRETE based on-intent-to use under Section 1(b) of the Lanham Act.

19. To date, Applicant has not filed any documents with the United States Patent and Trademark Office to state that it has commenced use of its mark.

20. The dates of first use for each of Opposer's PLEXI Marks, as shown in the registrations for the PLEXI Marks, are decades before Applicant's intent-to-use filing date of May 21, 2012.

21. Opposer's dates of first use claimed in the registrations for every one of the PLEXI Marks is earlier than any date upon which Applicant may rely.

22. "PLEXI" is the dominant feature of Opposer's PLEXICHROME mark.

23. “PLEXI” is the dominant feature of Opposer’s PLEXICOURT mark.
24. “PLEXI” is the dominant feature of Opposer’s PLEXI-CUSHION mark.
25. “PLEXI” is the dominant feature of Opposer’s PLEXIPAVE mark.
26. “PLEXI” is the dominant feature of Opposer’s PLEXI-TRAC mark.
27. “PLEXI” is the dominant feature of Opposer’s PLEXIFLOR mark.
28. “PLEXI” is the dominant feature of Applicant’s PLEXICRETE mark.
29. Applicant’s PLEXICRETE mark and Opposer’s PLEXICHROME mark are highly similar in sound and appearance
30. Applicant’s PLEXICRETE mark and Opposer’s PLEXICHROME mark create the same commercial impression.
31. Applicant’s PLEXICRETE mark and Opposer’s PLEXICOURT mark are highly similar in sound and appearance.
32. Applicant’s PLEXICRETE mark and Opposer’s PLEXICOURT mark create the same commercial impression.
33. Applicant’s PLEXICRETE mark and Opposer’s PLEXI-CUSHION mark are highly similar in sound and appearance
34. Applicant’s PLEXICRETE mark and Opposer’s PLEXI-CUSHION mark create the same commercial impression.
35. Applicant’s PLEXICRETE mark and Opposer’s PLEXIPAVE mark are highly similar in sound and appearance
36. Applicant’s PLEXICRETE mark and Opposer’s PLEXIPAVE mark create the same commercial impression.

37. Applicant's PLEXICRETE mark and Opposer's PLEXI-TRAC mark are highly similar in sound and appearance.

38. Applicant's PLEXICRETE mark and Opposer's PLEXI-TRAC mark create the same commercial impression.

39. Applicant's PLEXICRETE mark and Opposer's PLEXIFLOR mark are highly similar in sound and appearance.

40. Applicant's PLEXICRETE mark and Opposer's PLEXIFLOR mark create the same commercial impression.

41. The Applicant's PLEXICRETE goods as set forth in Application Serial No. 85/164,386 and the goods set forth in the registrations for the PLEXI Marks, many of which cover coatings and materials for use on concrete surfaces, are highly related.

42. Opposer's products identified under the PLEXI Marks are sold as sport surfacing systems and surface preparation applications to athletic venues, hospitality venues, health clubs, and to residential consumers.

43. Applicant and Opposer's products are offered to and utilized by the same or similar consumers.

44. Applicant's PLEXICRETE mark does not limit the channels of trade through which its PLEXICRETE products travel, nor does it limit the consumers to whom the products are directed.

45. The products identified in the application for Applicant's PLEXICRETE mark are presumed to travel through all customary channels of trade for such products and to be directed towards all relevant consumers.

46. There are no limits on channels of trade or consumers for products identified by Opposer's PLEXI Marks.

47. Products identified by Applicant's PLEXICRETE mark are be sold or offered for sale through the same channels of trade as products identified by Opposer's PLEXI Marks.

48. In view of the similarity between the respective marks and the overlapping channels of trade and consumers, and the highly related nature of the products of the respective parties, it is alleged that Applicant's PLEXICRETE mark so closely resembles Opposer's PLEXI Marks so as to be likely to cause confusion or to cause mistake or to deceive.

49. The Applicant's use of PLEXICRETE falsely suggests an association with or approval by Opposer of products identified by Applicant's PLEXICRETE mark and will create confusion in the marketplace.

50. Customers are likely to believe incorrectly that products identified by Applicant's PLEXICRETE mark originate from and or are authorized, endorsed or sponsored by Opposer.

51. Customers are likely to expect that products identified by Applicant's PLEXICRETE mark are of the same quality as products branded with Opposer's California Product Registrations.

52. The registration of Applicant's PLEXICRETE Mark, if permitted, will lessen the capacity of Opposer's PLEXI Marks to identify and distinguish Opposer's products, thereby causing harm to Opposer.

53. Opposer's PLEXI Marks as set forth in Opposer's registrations have been used by Opposer and not abandoned since a date long prior to any date on which Applicant may rely.

54. Applicant's PLEXICRETE mark as shown by Application Serial No. 85/164,386 is confusingly similar to the PLEXI Marks set forth in Opposer's Registrations.

55. The goods in Applicant's PLEXICRETE Application are related to the goods identified by Opposer's PLEXI Marks shown in Opposer's registrations.

56. Opposer will be damaged by the registration sought by the Applicant because such registration will support and assist Applicant in the confusing and misleading use of the PLEXICRETE mark, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

57. Registration of the PLEXICRETE mark therefore should be refused pursuant to Section 2(d) of the Trademark Act of 1946, as amended (15 U.S.C. §1052(d)), on the grounds that the Applicant's PLEXICRETE mark so resembles the PLEXI Marks shown in Opposer's Registrations Nos. 1,759,340 for PLEXICHROME; 1,124,927 for PLEXICOURT; 971,728 for PLEXI-CUSHION; 894,446 for PLEXIPAVE; 971,727 for PLEXI-TRAC; and 1,950,495 for PLEXIFLOR as to likely cause confusion or to cause mistake or to deceive when used on or in connection with the goods of Applicant, all to the detriment of Opposer.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that the registration of the mark PLEXICRETE, Application Serial No. 85/630325 be refused.

Respectfully submitted,

California Products Corporation

By its attorneys,

/Andrea J Mealey/
Andrea J. Mealey
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Fax: (617) 345-9020

Dated: February 15, 2013

CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of February 2013, I served a true and accurate copy of the foregoing Notice of Opposition, via Federal Express overnight mail, postage prepaid upon the Correspondent Address for the Applicant:

**Robert M. Brodsky
36 Diamond Crest CT
Baltimore, MD 21209-1500**

/Andrea J Mealey/_____
Andrea J. Mealey